



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,809	12/23/2005	Christophe Mathoulin	062845-5052 US	5678
28977	7590	03/03/2008		
MORGAN, LEWIS & BOCKIUS LLP			EXAMINER	
1701 MARKET STREET			WOODALL, NICHOLAS W	
PHILADELPHIA, PA 19103-2921				
		ART UNIT	PAPER NUMBER	
		3733		
		MAIL DATE	DELIVERY MODE	
		03/03/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,809

Applicant(s)

MATHOULIN ET AL.

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received on 12/06/2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

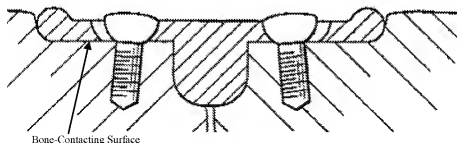
3. Claims 1-6 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Huebner (U.S. Publication 2004/0127901).

Regarding claim 1, Huebner discloses a device comprising lateral holes and a bone-contacting surface (reference Figure 1 below). The lateral holes are capable of inserting screws at an angle to direct the screws towards the outside edge of the plate. Huebner shows various embodiments of the device, one including a bone-contacting surface flat face that contacts the surface of the bone, wherein the entire bone contacting surface is flat. The examiner would like to note that the embodiment shown in Figures 8 and 9 of the reference may include a post or an aperture or have no features as disclosed by the reference (page 6 paragraph 58). Therefore, the embodiment including either an aperture or no features would have a bone-contacting surface that is entirely flat and discloses the limitations of the claim. Regarding claim 2, Huebner further discloses a device that is circular in shape. Regarding claims 3 and 4,

Art Unit: 3733

Huebner further discloses a device wherein the upper face comprises a recess (claim 3). The recess occupies a majority of the upper face of the device and is the form of a hollow spherical cap (claim 4; page 6 paragraph 58). Regarding claim 5, Huebner further discloses a device further comprising at least one screw hole in the form of a hollow spherical section and a screw with a matching head to allow a multidirectional orientation of the screw. Regarding claim 6, Huebner discloses the device further comprising a number of holes close to the number of bone being treated. In one embodiment, Huebner shows a device comprising four holes to allow screws to pass into four different bones. Regarding claim 19, Huebner discloses a device wherein the plate comprises a number of screw holes equal to the number of bones to be treated. Regarding claim 20, Huebner discloses an embodiment wherein the device is connected to four carpal bones with four screws going through the four holes (page 3 paragraph 28). Regarding claim 21, Huebner discloses a device comprising a bone-contacting surface and lateral holes capable of inserting screws to fix the screws to bones to be treated, wherein the entire bone-contacting surface is flat and comprising holes for receiving screws having axes that are tilted in relation to the flat bone-contacting surface.

Figure 1



Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huebner (U.S. Publication 2004/0127901) in view of Huebner (U.S. Publication 2004/0102778).

Regarding claim 7, Huebner discloses a device further comprising a central hole that is capable of allowing a sliding engagement between the device and a spindle. Huebner fails to disclose the device comprising markings on the periphery of the device. Huebner teaches a similar device comprising reference marks in order to indicate an angular or linear disposition (page 5 paragraphs 67 and 68 and page 6 paragraphs 68 and 69). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Huebner with reference markings in view of Huebner in order to indicate an angular or linear disposition.

6. Claims 8 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huebner (U.S. Publication 2004/0127901) in view of Huebner (U.S. Publication 2004/0102778) further in view of Weiss (U.S. Patent 6,179,839).

Regarding claims 8 and 13-18, the combination of Huebner and Huebner disclose the invention as claimed except for a set of instruments comprising a reamer. Weiss teaches a device further comprising a set of instruments including a reamer in order to rasp or burr away bone in a precise location where the device is to be

positioned and affixed (column 5 lines 36-55). It would have been obvious to one having ordinary skill in the art at the time of the invention to manufacture the device of Huebner as modified by Huebner with a set of instruments including a reamer in view of Weiss in order to rasp or burr away bone in a precise location where the device is to be positioned and affixed.

7. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huebner (U.S. Publication 2004/0127901) in view of Huebner (U.S. Publication 2004/0102778) further in view of Weiss (U.S. Patent 6,179,839) further in view of McGuire (U.S. Patent 5,374,270).

Regarding claims 9 and 12, the combination of Huebner, Huebner, and Weiss disclose the invention as claimed except for the reamer including a cannula and the device further comprising a spindle. Weiss teaches a device wherein the reamer further includes a cannula and further comprising a spindle, wherein the spindle is capable of being placed through the cannula of the reamer in order to insert the spindle into tissue for fixing material to the bone (column 2 lines 60-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Huebner modified by Huebner further modified by Weiss wherein the reamer includes a cannula and the device further comprises a spindle in view of McGuire in order to insert the spindle into tissue for fixing material to the bone.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huebner (U.S. Publication 2004/0127901) in view of Huebner (U.S. Publication

2004/0102778) further in view of Weiss (U.S. Patent 6,179,839) further in view of Griner (U.S. Publication 2004/0039450).

Regarding claims 10 and 11, the combination of Huebner, Huebner, and Weiss discloses the invention as claimed except for providing a provisional implant identical to the actual implant. Griner teaches using provisional implants that are identical to the actual implant in order to test the fit and alignment with a bone that has been reshaped by a surgeon without the possibility of damaging the actual implant (page 1 paragraph 002). It would have been obvious to one with ordinary skill in the art at the time the invention was made to manufacture the device of Huebner modified by Huebner further modified by Weiss with an identical provisional implant in view of Griner in order to test the fit and alignment with a bone that has been reshaped by a surgeon without the possibility of damaging the actual implant.

Response to Arguments

9. Applicant's arguments filed 12/06/2007 have been fully considered but they are not persuasive. The examiner has presented a new ground of rejection as necessitated by the amendments making this office action **FINAL**.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733